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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|---|---|---|---|---|
| 09/840,435 | 04/23/2001 | Diana Kim Fisler | 7105 | 4163 |

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| EXAMINER | |
|---|---|
| COLAIANNI, MICHAEL | |
| ART UNIT | PAPER NUMBER |
| 1731 | |

DATE MAILED: 05/02/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

| Office Action Summary | Application No. 09/840,435 | Applicant(s) Fisler et al. |
|---|---|---|
| | Examiner Michael Colaianni | Art Unit 1731 |

*-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --*

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136 (a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

1) ☒ Responsive to communication(s) filed on *Apr 23, 2001* .

2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.

3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

**Disposition of Claims**

4) ☒ Claim(s) *1-27* is/are pending in the application.

4a) Of the above, claim(s) *24-27* is/are withdrawn from consideration.

5) ☐ Claim(s) _____ is/are allowed.

6) ☒ Claim(s) *1-23* is/are rejected.

7) ☐ Claim(s) _____ is/are objected to.

8) ☐ Claims _____ are subject to restriction and/or election requirement.

**Application Papers**

9) ☐ The specification is objected to by the Examiner.

10) ☐ The drawing(s) filed on _____ is/are a) ☐ accepted or b) ☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.

If approved, corrected drawings are required in reply to this Office action.

12) ☐ The oath or declaration is objected to by the Examiner.

**Priority under 35 U.S.C. §§ 119 and 120**

13) ☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a) ☐ All b) ☐ Some* c) ☐ None of:

1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____ .
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

*See the attached detailed Office action for a list of the certified copies not received.

14) ☒ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

a) ☐ The translation of the foreign language provisional application has been received.

15) ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

**Attachment(s)**

1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s). *1*
4) ☐ Interview Summary (PTO-413) Paper No(s). _____
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other:

***Election/Restriction***

1. Restriction to one of the following inventions is required under 35 U.S.C. 121:

   I. Claims 1-23, drawn to a glass fiber composition, classified in class 501, subclass 35.

   II. Claims 24-27, drawn to a method of making glass fibers, classified in class 65, subclass 475.

2. The inventions are distinct, each from the other because of the following reasons: Inventions I and II are related as process of making and product made. The inventions are distinct if either or both of the following can be shown: (1) that the process as claimed can be used to make other and materially different product or (2) that the product as claimed can be made by another and materially different process (MPEP § 806.05(f)). In the instant case the product as claimed may be made by another and materially different process, such as a sol-gel method.

3. Because these inventions are distinct for the reasons given above and have acquired a separate status in the art as shown by their different classification, restriction for examination purposes as indicated is proper.

4. During a telephone conversation with Robert Touslee on April 22, 2003 a provisional election was made without traverse to prosecute the invention of Group I, claims 1-23. Affirmation of this election must be made by applicant in replying to this Office action.

Claims 24-27 are withdrawn from further consideration by the examiner, 37 CFR 1.142(b), as being drawn to a non-elected invention.

5. Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 CFR 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of inventorship must be accompanied by a request under 37 CFR 1.48(b) and by the fee required under 37 CFR 1.17(i).

***Claim Rejections - 35 USC § 103***

6. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

7. The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.

2. Ascertaining the differences between the prior art and the claims at issue.

3. Resolving the level of ordinary skill in the pertinent art.

4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

8. Claims 1-23 are rejected under 35 U.S.C. 103(a) as being unpatentable over Ikeda et al. 4367012.

Ikeda et al. teaches a water resistant glass composition having silicon dioxide, alumina, boron oxide, and sodium within the claimed ranges (col. 3, lines 33-45). While Ikeda also uses zinc oxide in the composition, the zinc may be present in an amount of as small as 1 wt.% which is deemed to be a small enough amount to be encompassed by the "consisting essentially of" transitional language. Moreover, the addition of zinc oxide does not "materially affect the basic and novel characteristics" of the claimed invention because the zinc oxide enhances the moisture resistance of the glass (col. 5, lines 36-48). Thus, because Ikeda et al. teaches applicant's claimed composition, the properties achieved by the composition must, obviously, be the same. Therefore, the properties of Ikeda's composition must be the same as applicants.

It would have been prima facie obvious at the time the invention was made that the Ikeda et al.'s composition has the same properties as claimed by applicant because Ikeda et al.'s ranges overlap with applicant's claimed ranges. This fact establishes a prima facie case of obviousness (see MPEP §2144.05).

9. Claims 1-21 are rejected under 35 U.S.C. 103(a) as being unpatentable over De Meringo et al. WO 99/57073.

****The US Patent equivalent 6313050 of WO 99/57073 will be used to reference De Meringo's WO 99/57073 various teachings.****

De Meringo et al. teach a glass composition having silicon dioxide; alumina; boron oxide; calcium oxide; and sodium oxide/potassium oxide in overlapping ranges with applicant's claimed composition (col. 5, claim 1). The iron, phosphorous and titanium compounds are optional because their ranges all include zero as an option. Thus, the composition is taught by De Meringo et al. Thus, because De Meringo et al. teaches applicant's claimed composition, the properties achieved by the composition must, obviously, be the same. Therefore, the properties of De Meringo's composition must be the same as applicants.

It would have been prima facie obvious at the time the invention was made that the De Meringo et al.'s composition has the same properties as claimed by applicant because De Meringo et al.'s ranges overlap with applicant's claimed ranges. This fact establishes a prima facie case of obviousness (see MPEP §2144.05).

## *Conclusion*

10. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Michael Colaianni whose telephone number is 703-305-5493. The examiner can normally be reached on Monday to Friday from 8:00 AM to 4:30 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Steven Griffin, can be reached on (703) 308-1164. The fax phone number for the organization where this application or proceeding is assigned is 703-305-7115.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-0651.

MICHAEL COLAIANNI
PRIMARY EXAMINER

Art Unit 1731
April 30, 2003